



REMARKS/ARGUMENTS

Claim 1 has been amended. Claims 2-11 remain in this application. No new matter has been added.

Reconsideration of the rejection of Claim 1 under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the method/process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim, is requested, in light of the following arguments.

Reconsideration of the rejection of Claim 1 under 35 U.S.C. 112, second paragraph, because it merely recites a use without any active, positive steps delimiting how this use is actually practiced, is also requested, in light of the following arguments.

The rejections are believed to be improper. The relevant section of the MPEP, 2173.05(q) "Use" Claims, states in part (portion underlined and put in bold for emphasis):

"Attempts to claim **a process** without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

Other decisions suggest that a more appropriate basis for this type of rejection is 35 U.S.C. 101. In Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition **of a process**: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was definite, but

that it was not a proper process claim under 35 U.S.C. 101: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid."

Claim 1 is not for **a process**. Rather, Claim1 and the subsequent claims which depend on it are apparatus claims. There is no requirement in the MPEP or in the Patent Law, to applicant's knowledge, for the setting out of process steps in an apparatus claim. Reconsideration of the rejections is therefore respectfully requested.

Claims 1 has been amended for clarification, but the amendments were made for reasons unrelated to patentability.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned. **"Version with markings to show changes made."**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend claim 1 as follows:

1. (AMENDED) An apparatus for preventing wrinkling of a polishing pad
bordering a substrate during chemical mechanical polishing of a substrate, comprising:

a rotatable[ry polishing] head assembly having a shallow recessed face
adapted to centerly hold [the upper back edge of] a substrate;

a non-rotat[ry]ing cylindrical actuator assembly[, having a bottom surface, is]
coaxially oriented about the outer edge of said rotary polishing head
assembly;

a ditched ring removably attached to [said] a bottom surface of said non-rotary
cylindrical actuator assembly;[, said ditched ring having a top and bottom surface.]

a multiplicity of conduit grooves formed in said bottom [section] surface of said
ditched ring [permitting a boundary layer of abrasive slurry to flow unimpeded to a
rotating substrate];

a rotary polishing platen having [an upper surface:] a polishing pad
[fixedly attached to said upper] surface facing said substrate;

a polishing slurry containing a mechanical abrasive deposited on [said
upper surface of] said polishing pad.

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